

REMARKS

This Response is submitted in reply to the Office Action dated April 4, 2006. Claims 1 and 18 have been amended. Claim 19 was previously cancelled. Claims 11 to 17, 21 and 22 stand allowed. No new matter has been added.

A Petition for a One Month Extension of Time to file this Response and a Supplemental Information Disclosure Statement are submitted herewith. Please charge deposit account number 02-1818 for any fees which are due and owing in connection with this Petition, this Response and this Supplemental IDS.

In responding to Applicants' arguments pertaining to the terms "offer" and "value" not being interchangeable with respect to the pending claims as set forth in the Response to Final Office Action dated February 22, 2006, the Examiner states that:

The Applicants' assertions are primarily based on the use of these respective terms in a given set of claims and not the terms themselves for while their particular use is separate by an associated acceptance/rejection feature or the lack thereof in the claims, the term –value- and –offer- does not in of itself imbue specific functional definition. Therefore, while the claim limitations associated with the specific aspects of an acceptance/rejection feature are noted in a subset of the claims, the claims as presented could present a –value- for acceptance/rejection equally to presenting an –offer- for acceptance/rejection. In kind, an –offer- may include an acceptance/rejection aspect as the term –value- may also include an acceptance/rejection feature. Hence though the terms may have a degree of distinction, this distinction for the purposes of examination is limited to the explicit incorporation of claim features directed to the acceptance/rejection feature associated with the respective term's –offer- accompanying language and limitations, not the respective term considered in isolation.

This reasoning ignores the law by improperly viewing the claim language completely independent of the context of the claim in which such language appears and of the specification. It is well established that claims must be read in view of the specification, of which they are a part. *Markman v. Westview Instruments, Inc.*, 52 F. 3d 967, 979 (Fed. Cir. 1995). The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose. *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996). Applicants have enclosed a copy of the recent *Phillips v. AWH Corp.* decision (415 F. 3d 1303) for

the Examiner's edification of the law regarding properly viewing the claims in light of the context of the claims and the specification.

As previously described in the Response to Final Office Action dated February 22, 2006, the specification fully supports Applicants position that "offers" and "values" are not interchangeable, but rather are different terms with different interpretations. For example, page 13, line 8 to page 14, line 17 of the specification discloses that each player selectable selection has a value associated with it and not until the player picks one of the selections to reveal the associated value does the revealed associated value form the player's offer which the player may accept or reject. In another example, page 17, lines 3 to 5 of the specification discloses that "[a]fter the gaming device displays the value associated with the picked selection, the player may accept or reject the revealed value as their offer...". Thus, if only the value associated with the player's picked selection forms the player's offer which the player may accept or reject (and the remaining values not associated with the player's picked selection do not form the player's offer and thus the player may not accept or reject these values), Applicants respectfully submit that, when read in view of the specification, the term "value" and the term "offer" must have separate definitions with separate interpretations and are not interchangeable with respect to the pending claims.

Additionally, page 14, lines 18 to 20 of the specification states that "...if the player rejects an offer, the value associated with that rejected offer is available for the gaming device to reassign or reassociate with another masked selection in subsequent rounds." Thus, Applicants respectfully submit that if a value is associated with a rejected offer and the value is available for a subsequent round, the term "value" and the term "offer" must have separate definitions with separate interpretations and are not interchangeable with respect to the pending claims. Accordingly, Applicants submit that contrary to the Examiner's statement in the Office Action, the claims as presented do not present a "value" for acceptance/rejection equally to presenting an "offer" for acceptance/rejection.

The Office Action rejected Claims 1 to 10, 18 and 20 under 35 U.S.C. §102(e) as being anticipated by Baerlocher et al. (U.S. Patent No. 6,648,754).

Baerlocher discloses a gaming device having a game with a plurality of player selectable selections. A plurality of the selections are each associated with a numbers of steps. Different numbers of steps are associated with different offers. The gaming device enables a player to pick selections to accumulate steps. The gaming device enables the player to accept or reject the offer associated with the accumulated number of steps. The game ends when the maximum number of offers have been awarded, the player accepts an offer, or the player's accumulated steps meet or exceed a termination limit equal to a number of steps.

Amended independent Claim 1 is directed to a gaming device including a game which includes a plurality of offers, wherein the plurality of offers are payable to a player and a plurality of player selectable masked selections. The gaming device includes a display device, an input device, a memory device storing a plurality of instructions and a processor adapted to communicate with the display device and the input device. The processor is operable to execute the instructions to operate with the display device and the input device, for each play of the game, to: (a) directly and individually associate the offers with the selections, such that each offer is individually associated with a separate one of the selections, (b) enable the player to select one of the selections, (c) reveal the offer directly and individually associated with the selected selection to the player, (d) enable the player to accept or reject the revealed offer, (e) repeat steps (a) to (d) at least once if the player rejects the revealed offer, wherein if the player rejects the revealed offer, for the repeat of step (a) the revealed offer is directly and individually reassociated with one of the masked selections for at least one subsequent selection by the player, and (f) if the player accepts the revealed offer, pay the revealed offer to the player.

The Examiner is basing this rejection on two different interpretations of Baerlocher. Applicants respectfully disagree with the Examiner's reasoning throughout the Office Action pertaining to these interpretations.

Under a first interpretation of Baerlocher, the Office Action states that the offers (100) in Baerlocher are directly and individually associated with the selections (108). Applicants respectfully submit that under this first interpretation, amended independent Claim 1 is patentably distinguished over Baerlocher. As previously submitted in the Response to Office Action dated October 12, 2005, in Baerlocher the offers are associated with different numbers of steps which are themselves associated with the selections. The Office Action acknowledges this indirect association by stating that “[t]his ‘association’ between the masked selections and the offer would be defined by the mapping of the resultant number of accrued steps for any given selection during the game to their corresponding credit values shown in col. 10, lines 13 to 14 and Fig. 5”. On the other hand, in the gaming device of amended independent Claim 1, the offers are directly associated with the selections. Accordingly, for this reason alone, Applicants respectfully submit that under the Examiner’s first interpretation of Baerlocher, amended independent Claim 1 is patentably distinguished over Baerlocher and in condition for allowance.

Under a second interpretation of Baerlocher, the Examiner stated that the values of the steps (110) in Baerlocher are the offers in the gaming device of amended independent Claim 1. Applicants respectfully submit that under this second interpretation, amended independent Claim 1 is patentably different than Baerlocher because the values of the steps in Baerlocher are not payable to the player. In Baerlocher, the offers are payable to the player (if the player accepts a revealed offer) but the values of the steps are not. For example, as seen in Fig. 5B of Baerlocher, the player’s picked selection revealed seven accrued steps. In this example, the value of seven (associated with the revealed number of steps) is not payable to the player, but the offer of thirty (associated with the seven accrued steps) is payable to the player. Accordingly, if the value of the steps in Baerlocher is interpreted as the offer, then the offer is not payable to a player (and subsequently paid if the player accepts the revealed offer). On the other hand, in the gaming device of amended independent Claim 1, the offer is payable to the player (and subsequently paid if the player accepts the revealed offer). Accordingly, for this reason alone, Applicants respectfully submit that under the

Examiner's second interpretation of Baerlocher, amended independent Claim 1 is patentably distinguished over Baerlocher and in condition for allowance.

Claims 2 to 10 depend directly or indirectly from independent Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Similar to amended independent Claim 1, independent Claim 18 is directed to a method of operating a gaming device including, amongst other elements, directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein the plurality of offers are each payable to a player, enabling the player to pick one of the selections and revealing the offer directly and individually associated with the picked selection to the player. The method also includes enabling the player to accept or reject the revealed offer, providing the offer to the player if the player accepts the offer or if the offer is a last offer, and repeating these steps if the player rejects the offer and the offer is not the last offer, wherein if the player rejects the revealed offer, the revealed offer is directly and individually reassociated with one of the selections for at least one subsequent selection by the player. For the reasons described above with respect to amended independent Claim 1, Applicants respectfully submit that under either interpretation of Baerlocher, amended independent Claim 18 is patentably distinguished over Baerlocher and in condition for allowance.

Claim 20 depends directly from independent Claim 18 and is also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in this claim.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: August 1, 2006